

Serial No: 10/056,457
Art Unit: 2879

REMARKS SECTION

REMARKS

Reconsideration of the FINAL rejection of the rejection of the present pending patent application under 35 USC 103(a) is hereby requested.

Independent claim 1 remains in the application. The remaining depending claims are cancelled without prejudice.

Independent claim 1 and dependent claims 4, 5, 6 and 12 stand rejected as being unpatentable over Thornton Jr. '758 in view of Wada et al. '940. Examiner states that the combination of Thornton Jr. and Wada et al teaches each and every limitation of claim 1.

Applicant respectfully disagrees because Applicant believes that the combination of Thornton Jr. and Wada et al is improper. Examiner notes that the Thornton Jr. reference '758 discloses a fill of mercury and argon. Applicant wishes however, to point out that the Thornton Jr. '758 reference does not teach or suggest the fill also comprising aluminum or gallium. Examiner however states that the Wada et al reference '940 recites an aluminum chloride fill.

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Applicant wishes however, to point out that the Wada et al reference relates to a sodium-based lamp, not a mercury-based lamp. Applicant's invention is a mercury-based lamp. The Wada et al reference teaches that it specifically omits the use of mercury in the Wada et al lamp, as recited in Wada et al, in column 1, lines 10-11, and moreover, the Wada et al reference shuns mercury, as stated in column 5, lines 49-54 citing the negative characteristics of mercury, thus teaching away from the invention of Applicant!

Clearly, one skilled in the art would not be drawn to combine the Wada et al reference in conjunction with the Thornton Jr. reference, particularly after seeing no basis for Applicant's unique combination of elements for a lamp as the present invention.

The Federal Circuit has stated that "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.", *In re Geiger*, 815 F.2d 686, 2 USPQ 2d 1276 (Fed. Cir. 1987). There is no incentive to create a mercury-based lamp by combining aluminum fill of a

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sodium-based lamp from Wada et al., with the mercury fill in the mercury-based lamp of the Thornton Jr. reference, particularly when Wada et al. teaches away from the use of mercury in combination with aluminum in a lamp.

Withdrawal of the rejection of the remaining amended independent claim as being obvious under 35 USC 103 under the combination of references to Thornton, Jr. and to Wada et al is thus earnestly solicited. None of the remaining cited art is applicable to the independent claim 1 as currently amended, and therefore need not be addressed. Those references simply are not pertinent to the remaining claim as amended.

It is therefore believed that the claims as amended now recite allowable subject matter, and passage to allowance of the remaining claims is earnestly solicited.

Should the Examiner consider that the remaining independent claim 1 as currently amended does not place this application for allowance, the Examiner is requested to please enter the claim for the purpose of filing an appeal.

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Should the Examiner however believe that any minor issue remains unresolved, the Examiner is invited to call the undersigned for a discussion of same.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'OJ Meegan', followed by a horizontal line.

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